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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,804	07/24/2001	Surya Prakash	06618/408002/CIT2942-D	7226
20985	7590	05/02/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			MERCADO, JULIAN A	
			ART UNIT	PAPER NUMBER
			1745	
DATE MAILED: 05/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/912,804	PRAKASH ET AL.	
	Examiner	Art Unit	
	Julian Mercado	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The rejection of claims 1-5 and 11-15 under 35 U.S.C. 112, second paragraph has been obviated.

This Office action presents a new ground of rejection and is therefore made NON-FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanan et al. (U.S. Pat. 5,945,231)

The rejection is maintained for the reasons of record.

Applicant submits that Narayanan et al. does not teach that the catalyst decal disclosed in Narayanan et al. can be used with a PSSA-PVDF membrane. However, the examiner asserts that the disclosed crosslinked PSSA and Kynar alternative ink (which itself is a membrane layer, i.e. the aforementioned catalyst decal) reads on a PSSA-PVDF membrane. Narayanan et al.

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specifically discloses that an *additional* PVDF layer as a primary catalyst may be applied thereto.
[emphasis added]

Applicant's arguments have been fully considered, however they are not persuasive. It appears to the examiner that applicant is interpreting Narayanan et al. in a different light under the doctrine of claim differentiation. For the record, the crosslinked PSSA and Kynar is deemed equivalent to the PSSA-PVDF membrane, and the primary catalyst used with PVDF is deemed equivalent to the catalyst ink. Of note, the PVDF is in powder form and specifically disclosed as being dispersed easily with the catalyst ink.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(New rejection)

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanan et al. in view of Prakash et al. (U.S. Pat. 6,444,343)

The teachings of Narayanan et al. are discussed above.

Narayanan et al. does not explicitly teach a plasticizer as part of the catalyst ink. However, as discussed in the prior Office action, Prakash et al. a plasticizer such as dimethylacetamide. (col. 14 line 35-42) The skilled artisan would find obvious to employ a

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plasticizer in Narayanan et al.'s invention in order to effect catalytic active material deposition onto the polymer membrane. (ib.)

Double Patenting

Claims 1, 2, 4, 5 and 11-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,444,343 B1 in view of Cabasso et al. (U.S. Pat. 5,783,325).

Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,444,343 B1 in view of Cabasso et al. (U.S. Pat. 5,783,325), and further in view of Denton et al. (U.S. Pat. 5,865,958).

The rejection(s) are maintained for the reasons of record.

Applicant's arguments have been fully considered, however they are not found persuasive. The examiner notes that the obviousness-type double patenting rejection now relies solely on claims 1-6 of the '343 B1 Patent which is the same statutory type of invention as the instant claims.

As to the claims not suggesting applying a catalyst ink onto a PSSA-PVDF membrane, the examiner asserts that the suggestion for such a modification is not relied upon to come from the claims themselves but rather from the teachings of Cabasso et al. As to applicant's submission that only the subject matter encompassed by the claims can be used in support of a double patenting rejection, while this may be true for the *disclosure* of the patent [emphasis added], it does not apply to teachings which may be found from other prior art. Hence, the

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obviousness-type double patenting rejection relies on Cabasso et al. for these teachings and for the modification to apply these teachings to the claims in the '343 B1 Patent.

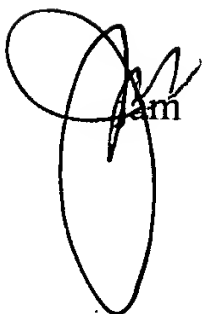
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to be "J. Mercado", enclosed within a large, loopy oval shape.

PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER